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**MAILED**

SEP 14 2010

**OFFICE OF PETITIONS**

In re Application of :  
Hansen et al. : DECISION ON APPLICATION  
Patent Number: 7,713,738 : FOR PATENT TERM ADJUSTMENT  
Issue Date: 05/11/2010 : and  
Application No. 10/776934 : NOTICE OF INTENT TO ISSUE  
Filing or 371(c) Date: 02/10/2004 : CERTIFICATE OF CORRECTION  
Attorney Docket Number: :  
366929-018US (396515) :  
:

This is a decision on the “APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(d),” filed July 9, 2010, including a Statement Under 37 CFR 1.705(b)(2). Patentee submits that the correct patent term adjustment to be indicated on the patent is a minimum of 864 days.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment (“PTA”) under 37 CFR 1.705(b), is hereby **DISMISSED**.

On April 17, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

On June 29, 2009, applicants timely submitted a request for review of patent term adjustment<sup>1</sup>. The application for patent term adjustment as it relates to the Office’s miscalculation of a four (4) month delay incurred by the Office in its non-final Office action, mailed April 17, 2007, pursuant to 37 CFR 1.702(a)(2), was dismissed in a Decision mailed March 24, 2010. The Decision dismissing the petition noted that the application file revealed that the non-final Office action, mailed April 17, 2007, addressed claims amended by applicants with the filing of the March 15, 2007 amendment and as such, the Office action was timely.

Patentee’s file the present petition again assert that an entitlement to a period of adjustment of 322 days of Office delay in connection with a four (4) month delay incurred by the Office in its mailing of a non-final Office action, mailed April 17, 2007. Patentees provide that “[t]he only

<sup>1</sup> Office records show that the Issue Fee payment was received in the Office on June 29, 2009.

amendments made to the claims in Patentee's March 15, 2007 response was to add several sequence identifiers in order to comply with the sequence rules." Further to this, Patentees assert that the Office failed to calculate overlap in connection with the mailing of a non-final Office action, mailed April 17, 2007, "[a]s the period of 4 Month Delay ended on April 17, 2007, and the 3 Year Delay began February 11, 2007, Applicants submit that these periods overlap by 66 days.

Patentee's also disagree with the Office's calculation of Office adjustment of 194 days in connection with the failure to issue a patent not later than four months after the date on which the issue fee was paid pursuant to 37 CFR 1.702(a)(4). However, Patentee's agree that this period overlaps with the period of adjustment pursuant to 37 CFR 1.703(f).

Patentee's arguments have been carefully considered. A review of the application file history confirms that the non-final Office action mailed April 17, 2007, addressed claims amended by applicants with the filing of the March 15, 2007 amendment. As such, the non-final Office action was timely pursuant to 37 CFR 1.702(a)(2)<sup>2</sup>.

Further to this, as the non-final Office action mailed April 17, 2007, was timely, there is no Office adjustment or overlap of 66 days with the period of adjustment pursuant to 37 CFR 1.703(f).

A review of the application file history also reveals that the Office included a 194-day adjustment of the patent term pursuant to 37 CFR 1.702(a)(4) in connection with the failure to issue a patent not later than four months after the date on which the issue fee was paid.

A further review of the application file history reveals that the Office errantly neglected to assess a reduction pursuant to 37 CFR 1.704(c)(8) in connection with the filing of an Information Disclosure Statement ("IDS") on March 23, 2009, after filing a reply to the final Office action on March 6, 2009. The reduction of 17 days, beginning on the day after the date the initial reply was filed, March 6, 2009, and ending on the date that the supplemental reply or other such paper was filed, March 23, 2009, is appropriate.

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<sup>2</sup> The response filed January 20, 2006, was not fully responsive to the Restriction Requirement, mailed July 20, 2005. Applicants were so notified in a Notice of Non-Compliant Amendment, mailed April 20, 2006. Applicants filed a "Second Response to Restriction Requirement," on June 27, 2006, which was also non-compliant. The Office mailed a Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice"), on September 19, 2006. Applicants reply to the Notice, filed March 15, 2007, amended claims 153, 160-165 and 167-168, in compliance with the Notice mailed September 19, 2006. The Office action mailed April 17, 2007, addressed, inter alia, claims 153, 160-165 and 167-168, which were amended in the March 15, 2007 amendment.

Moreover, applicants agree with the Office's calculation of delays pursuant to 37 CFR 1.704(c)(7), in connection with the filing of the responses on June 27, 2006; of 158 days and 86 days in connection with the filing of the amendments on June 27, 2006 and March 15, 2007 respectively. Application for PTA at p.4. 37 CFR 1.704(c)(7) reduces the period of reduction for the submission of a reply having an omission, which ends on the date that the reply or other paper correcting the omission was filed.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **seven hundred seventy-seven (777) days** (Office adjustments of 1481 days (1186 days + 295 days) reduced by applicant delays of 510 days (92 days + 158 days + 86 days + 87 days + 50 days + 17 days + 20 days) reduced by overlap (194 days)).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods/  
Attorney  
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT : 7,713,738 B2

DATED : May 11, 2010

INVENTOR(S) : Hansen et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 794 days.

Delete the phrase "by 794 days" and insert -- by 777 days--